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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|--|-------------|----------------------|---------------------------|------------------------|
| 09/871,605   | 06/01/2001  | Akihiro Teramachi    | 010713                    | 8594                   |
| 38834 7590 01/29/2007<br>WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP<br>1250 CONNECTICUT AVENUE, NW<br>SUITE 700<br>WASHINGTON, DC 20036 |             |                      | EXAMINER<br>CHOI, PETER H |                        |
|  |             |                      | ART UNIT<br>3623          | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>01/29/2007   | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/871,605

Applicant(s)

TERAMACHI, AKIHIRO

Examiner

Peter Choi

Art Unit

3623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 3-7, 9-12.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Michelle Tarae*  
C. Michelle Tarae  
Primary Patent Examiner  
Art Unit 3623

Continuation of 11. does NOT place the application in condition for allowance because: the applicant's arguments are not persuasive.

Applicant argues that the amendment dated August 8, 2006 overcomes the 35 USC 112, second paragraph rejection raised by the Examiner. While the Examiner agrees that "operator" would not be confused with a "computerized logic module", it still does not clarify any differences, if any, between said "operator" and the applicant who "operates" the claimed invention to obtain engineering information from members selected by said applicant ("operator"). In order to overcome the 35 USC 112, second paragraph rejection, the Applicant is required to clarify the difference between the "operator" and the applicant who operates the claimed invention. Is the "human operator" a separate entity (i.e., not the applicant) who is utilized to select members?

Applicant also argues that the Eisenhart-Dworkin combination does not teach the step of using a human operator to select members from which to request information by utilizing member information stored in the membership database. As asserted by the Examiner, and also cited by Applicant, Dworkin discloses that an electronic operator is used to select a member, and that a user is used to manually select an expert. The Examiner asserts that the "user" of Dworkin corresponds to the claimed "human operator". The Applicant argues that Dworkin does not disclose that information about the respondents is available for users in order to decide which respondent or respondents to direct a question to. The Examiner asserts that this is taught by the Eisenhart-Dworkin combination, as Eisenhart teaches the step of compiling a list of members according to member information (member profiles) and Dworkin teaches the step of selecting a specific expert respondent.

Applicant also argues that one of ordinary skill in the art would not have been motivated to combine the teachings of Eisenhart and Dworkin, as they deal with unrelated and non-analogous technologies. In response to applicant's argument concerning improper motivation to combine references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, the Examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in *re Sheckler*, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In *re Fine*, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170 USPQ 209 (CCPA 1971). Even if the references in the instant case do not expressly suggest the specific combination claimed by the inventor, an assertion which the Examiner contests, the courts have stated "to support [a] conclusion that claimed combination is directed to obvious subject matter, references must either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings." *Ex parte Clapp*, 227 USPQ 972, 973 (BdPatApp&Int 1985). Furthermore, The Courts have already established that "[h]aving established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'" In *re Bozek*, 163 USPQ 545, 549 (CCPA 1969). In the instant case, Eisenhart allows members to browse a directory listing of member and project profiles that include more information than was available from the pedestrian website [Paragraph 14]. Members can request direct contact with potential business partners to advance the evaluation for a potential partnership. Dworkin et al. also allows users to select an expert respondent to exchange ideas and information [Column 2, lines 7-10]. Both Eisenhart and Dworkin et al. are linked through their mutual teachings of selecting specific participants for collaboration in exchanging information. Dworkin et al. discloses the use of human operators and the usefulness of providing users with the opportunity to direct a question to an expert of his or her choice in the scenario of there being more than one expert available at the same time [Column 7, lines 8-10], which is a feature lacking in Eisenhart. The Applicant's citation of Dworkin's ability to provide expert respondents a way to answer questions via telephone (column 1, lines 45-50 and column 2, lines 12-14, as cited by Applicant) does not preclude the use of computers as a means of disseminating information from experts. Dworkin has the primary object of providing a method of delivering information by computer (column 2, lines 38-39), and the further object of providing expert responses to technical questions using an on-line system (column 2, lines 40-42), where the user gains access to the system through a network connection (column 2, lines 5-6). Dworkin also teaches that, even when the telephone is used to answer questions, the user typically gains access to the central computer by using a personal computer connected to a modem which is connected to a telephone line (column 2, lines 2-3). The Examiner asserts that Dworkin does not teach away from Eisenhart, and that Dworkin allows users to answer questions via telephone or computer; thus, the Examiner maintains that one of ordinary skill in the art would have been motivated to combine the Dworkin and Eisenhart references.